UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

GOTTLIEB DEVELOPMENT LLC, Plaintiff, v. PARAMOUNT PICTURES CORPORATION, Defendant.	08 CV 02416 (DC)

MEMORANDUM OF LAW IN SUPPORT OF DEFENDANT'S MOTION TO DISMISS

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MEMORANDUM OF LAW IN SUPPORT OF DEFENDANT'S MOTION TO DISMISS

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, defendant Paramount Pictures Corporation ("Paramount") respectfully moves this Court to dismiss the Complaint of plaintiff Gottlieb Development LLC ("Gottlieb") for failure to state a cause of action.

PRELIMINARY STATEMENT

This lawsuit arises from the use of a pinball machine as a "prop" or set dressing during an approximately three-minute scene in the motion picture entitled "What Women Want" (the "Film"). Although most companies would typically pay a motion picture studio for the privilege of product placement, Gottlieb here complains that Paramount should pay Gottlieb for use of the pinball machine in the Film.

Gottlieb claims copyrights in the Backglass and Playfield portions[1] of the pinball machine, and in a trademark, "Gottlieb," which appears on the machine. The Playfield elements are simply not visible in the Film. Accordingly, any claims based on the copyrights in the Playfield elements must fail. Certain elements of the Backglass design are visible, but only for

[1] The backglass is the back, upright section; the playfield is the top of the machine.

de minimis periods of time totaling at most 25 seconds. Moreover, the only arguably discernable features are in the public domain; none of the arguably protectable features can be seen.

As to the trademark claim, the name "Gottlieb" appears on the side of the machine in three brief segments for less than nine seconds in total. Any observer not specifically looking for the name is unlikely even to notice it. Legally, such a brief exposure is simply not actionable. Since there is no legal support for any of Gottlieb's claims, the Complaint should be dismissed.

FACTUAL BACKGROUND

According to the Complaint,[2] Gottlieb is an Illinois LLC headquartered in New York, *see* Compl. ¶¶ 1, 4, which owns three registrations on file with the Copyright Office for the "Silver Slugger" pinball machine: (1) the "Silver Slugger pinball machine backglass design," Reg. No. VA 396-150 (the "Backglass"); (2) the "Playfield parts layout," Reg. No. VAu 176-502 (the "Playfield Layout"); and (3) the "Silver slugger pinball machine playfield design," Reg. No. VA 396-843 (the "Playfield Design") (collectively, the "Designs"). The deposit specimens allegedly submitted to the Copyright Office for the Backglass and the Playfield Layout were, as requested by the Court, provided to Paramount by Gottlieb's counsel. They are attached to the Declaration of Eleanor M. Lackman as Exhibits B and C, respectively.[3] Exhibit A to the Complaint allegedly shows the deposit specimen for the Playfield Design. Gottlieb also owns a supplemental trademark registration[4] for "GOTTLIEB" (the "Mark") for use in connection with non-gambling,

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[2] A copy of the Complaint in this action is attached to the Declaration of Eleanor M. Lackman, dated July 11, 2008 ("Lackman Decl.") as Exhibit A.

[3] Because Gottlieb has relied on the Film and Gottlieb's copyright and trademark registrations in its Complaint, the Court may consider the Film, the deposit specimens submitted to the Copyright Office and Gottlieb's trademark registration certificate without converting the present motion into a motion for summary judgment. *See, e.g., Dworin v. Deutsch*, No. 06 Civ. 13265 (PKC), 2008 WL 508019, at *2 (S.D.N.Y. Feb. 22, 2008).

[4] A supplemental registration means that a mark is capable of serving as a trademark but that no secondary meaning showing such recognition has been demonstrated. Accordingly, a mark on

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coin-operated amusement-type pinball machines." *See* Compl. ¶ 9; Lackman Decl., Ex. D. Gottlieb does not claim rights in the pinball machine as a whole or in any other word, mark or design appearing on the pinball machine.

The Film, a 126-minute romantic comedy starring Mel Gibson, Helen Hunt, Marissa Tomei and Alan Alda, was released in theaters in the United States on or about December 2000,[5] and was released on DVD in the United States on or about April 2001. The Film tells the fictional story of Nick Marshall (played by Mel Gibson), a chauvinistic advertising executive scaling the corporate ladder at one of Chicago's biggest advertising agencies. *See generally* Lackman Decl., Ex. E. Nick's fast-track to success is derailed when the agency hires a woman, Darcy McGuire (played by Helen Hunt), as the new creative director. As Nick reels from the news, he is mildly electrocuted by a product targeted to women, and the accident leaves him with the ability to hear the innermost thoughts of the women around him, including those of his new boss, Darcy. Although Nick initially tries to use his new "gift" as a way to steal ideas thought up by his female colleagues, he eventually uses his ability to hear women think as a way to understand them on a deeper level, which ultimately helps him to win a coveted Nike women's division account, as well as Darcy's heart.

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the Supplemental Register is not entitled to a presumption of validity. *See Jewish Sephardic Yellow Pages, Ltd. v. DAG Media, Inc.*, 478 F. Supp. 2d 340, 356 n.23 (E.D.N.Y. 2007); *Loctite Corp. v. National Starch & Chem. Corp.*, 516 F. Supp. 190, 203 (S.D.N.Y. 1981).

[5] Regardless of the merit of Gottlieb's copyright claims, it cannot recover damages arising from distribution of the Film in theatres, on DVD or on television prior to three years from the filing of the Complaint, or March 7, 2005, due to the three-year statute of limitations applicable to claims under the Copyright Act, 17 U.S.C. § 507(b) (2007). *See Kregos v. Associated Press*, 3 F.3d 656, 662 (2d Cir. 1993) ("when infringements occur during the limitations period, recovery may not be had for the earlier infringements; rather, '[r]ecovery is allowed only for those acts occurring within three years of suit'") (quoting *Stone v. Williams*, 970 F.2d 1043, 1049-50 (2d Cir. 1992)), *cert. denied*, 510 U.S. 1112, 114 S. Ct. 1056 (1994).

Gottlieb's claims arise from a scene set the day after the accident, at approximately 37 minutes into the Film, in which Nick participates in a brainstorming meeting in Darcy's office. In that scene, the pinball machine appears briefly, *see* Compl. ¶¶ 6, 12, alongside another pinball machine and other sports-related games. The scene lasts approximately three minutes, and the pinball machine does not appear anywhere else in the Film. As stated, the elements of the Playfield Layout and Playfield Design are simply not shown in the Film. The elements of the Backglass never appear *in toto*; small segments appear for *de miminis* periods of time only. Similarly, the name "Gottlieb" appears for an even shorter period of time.

ARGUMENT

I. Standard of Review

When deciding a defendant's motion to dismiss under Rule 12(b)(6), the court must "accept as true all of the factual allegations contained in the complaint," *Bell Atlantic Corp. v. Twombly*, 127 S. Ct. 1955, 1964 (2007), and "draw all reasonable inferences in plaintiff's favor." *Ofori-Tenkorang v. American Int'l Group, Inc.*, 460 F.3d 296, 298 (2d Cir. 2006). However, to withstand a 12(b)(6) motion to dismiss, the allegations in the complaint must meet the standard of "plausibility." *Twombly*, 127 S. Ct. at 1970. The complaint need not provide "detailed factual allegations," but the complaint must sufficiently state the grounds upon which the plaintiff's claim rests "through factual allegations sufficient 'to raise a right to relief above the speculative level.'" *ATSI Commc'ns v. Shaar Fund, Ltd.*, 493 F.3d 87, 98 (2d Cir. 2007) (quoting *Twombly*, 127 S. Ct. at 1965). Thus, although the court must take the plaintiff's allegations as true, "the claim may still fail as a matter of law . . . if the claim is not legally feasible." *In re Methyl Tertiary Butyl Ether Prods. Liab. Litig.*, 457 F. Supp. 2d 455, 459 (S.D.N.Y. 2006). Moreover, "bald assertions and conclusions of law will not suffice." *Law Offices of Curtis V. Trinko, L.L.P. v. Bell Atlantic Corp.*, 309 F.3d 71, 74 (2d Cir. 2002) (quotation marks omitted).

II. As a Matter of Law, Paramount's *De Minimis* Use of the Designs in the Film Does Not Infringe Gottlieb's Copyrights

Gottlieb's copyright claims fail for several reasons. In the first instance, as noted, the designs for the Playfield Layout and Playfield Design are simply not visible in the Film. As a result, there can be no valid claim of infringement as to those designs.

As to the Backglass, parts of it do appear in certain limited segments. But, *in toto*, the fleeting appearance of separate segments which, when accumulated, total only 25 or 26 seconds of exposure, is simply insufficient to be actionable. Legally, such use is *de minimis*.

Moreover, not all elements of the Backglass contain sufficient originality to qualify for copyright protection. For example, the basic design of a baseball field is not protectable. Thus, to the extent that the Court even needs to address the issue of substantial similarity, the relevant comparison would only be between what can be seen in the Film compared to protectable segments of the Backglass. As shown below, no protectable elements of the Backglass appear in the Film, much less for any sufficient period of time to be actionable.

A. Paramount's Use of Any Portions of the Backglass Is *De Minimis*

The Backglass area is visible for approximately 25 or 26 seconds in total, but not consecutively. Rather, different segments appear for short periods of time which, when cumulated, total 25 or 26 seconds. The entire Backglass area is only visible in three short shots lasting less than one second each. The remainder of the time, only the bottom half of the Backglass appears in the shot, and at no time is the Backglass in focus. Where, as here, the copyrighted works are "displayed in poor lighting," "at a great distance," "out of focus and displayed only briefly," there is no copyright infringement. *See Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 218 (2d Cir. 1998) (dismissing copyright infringement claim where defendant used plaintiff's photographs in film for total of 35.6 seconds, and the photographs were never in focus, primarily in the background and often obstructed from view by one of the actors); *see also Gordon v. Nextel Commc'ns*, 345 F.3d 922, 925 (6th Cir. 2003) ("Because [plaintiff's] illustrations appear fleetingly and are primarily out of focus, we find their use to be *de minimis*.").

B. Paramount's Fleeting Use of Portions of the Backglass Does Not Include Protectable Portions Thereof; Accordingly There Can Be No Copyright Infringement

The deposit sample of the Backglass which Gottlieb attests was produced to the Copyright Office does appear to contain protectable elements. *See* Lackman Decl., Ex. B. The design is of a standard baseball field within a stadium. The players are positioned as they would in a traditional baseball game, *but they are clad in full-body robotic-looking uniforms. The lower left hand corner shows a group of spectators, a few of whom are wearing non-mainstream hairstyles and retro-futuristic clothing reminiscent of "Star Trek."* The subjects of the italicized descriptions may well be copyrightable, but none of them are visible in the Film.[6]

What does appear is an accurate depiction of a baseball field and baseball player positions, which are public domain elements that are not protectable. *See ATC Distrib. Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 712 (6th Cir. 2005) (catalog illustrations of transmission parts intended to be accurate reproductions of the parts held not sufficiently original for copyright protection); *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 765 (9th Cir. 2003) (accurate portrayal of unadorned vodka bottle held not copyrightable); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980) ("the mere reproduction of the Disney characters in plastic . . . does not constitute originality as this Court has defined the

[6] The reverse side of the Backglass is an adjusted mirror image of the front that presumably allows light to illuminate certain bases during play. But none of this appears in the Film.

term"); *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 197 (S.D.N.Y. 1999) (denying copyright protection to photographs that were "'slavish copies' of public domain works of art").

Because no protectable elements appear in the Film, and because in any event what appears is *de minimis*, Gottlieb's copyright claims fail as a matter of law.[7]

III. Paramount's Fleeting Use of Gottlieb's Alleged Mark on Gottlieb's Own Product Cannot Give Rise to a Claim Under Section 43(a) of the Lanham Act

As stated above, Gottlieb allegedly owns a registration for the mark "GOTTLIEB," but on the Supplemental Register only. This means that "GOTTLIEB" is capable as serving as a trademark, *i.e.*, an identification of source, but that Gottlieb has failed to provide proof of secondary meaning to the U.S. Patent and Trademark Office. Since the registration dates to 1986, and was assigned to Gottlieb in 1998, one wonders why Gottlieb has not provided proof of secondary meaning to the Trademark Office so the registration could be converted to the Principal Register and be entitled to the benefits thereof. *See Jewish Sephardic Yellow Pages*, 478 F. Supp. 2d at n.23 ("it is only where the mark is registered on the Principal Register that the party challenging the mark must overcome a strong presumption of validity. . . . In contrast, where the mark is unregistered, or is registered only on the Supplemental Register, there is no such presumption.") (citations omitted). Under the circumstances, a reasonable presumption is that Gottlieb has not done so because no such proof exists. In any event, for purposes of this

[7] To the extent that Gottlieb's unfair competition and unjust enrichment claims (claims "Third" and "Fourth") are based on copyright infringement, that claim is preempted by the Copyright Act, 17 U.S.C. § 301 (2007). *See, e.g., American Movie Classics Co. v. Turner Entm't Co.*, 922 F. Supp. 926, 933 (S.D.N.Y. 1996) ("Courts in this Circuit have consistently held that claims for misappropriation of rights within the scope of copyright brought under New York unfair competition law are preempted."); *id.* at 934 ("Courts have frequently preempted . . . unjust enrichment claims that derive from the reproduction, use, or misappropriation of material covered by copyright protection.").

case, Gottlieb does not get the benefit of any presumptions from its supplemental registration. *See* 15 U.S.C. § 1094 (2007).

Aside from an unsupported allegation that Paramount's use of the Mark "is likely to cause confusion or to deceive," Compl. ¶ 19, Gottlieb's Complaint contains no factual underpinnings to show that secondary meaning exists, much less how consumer confusion is plausible under the circumstances alleged.

Before confusion can occur in the circumstances of this case, an appreciable number of viewers of the Film will have to perceive that the name GOTTLIEB appears on the machine, understand that it is a trademark, and be confused in some actionable sense. Gottlieb alleges confusion, Complaint ¶¶ 13-14, but the closest it comes to explaining how it occurs is in paragraph 19 where it alleges that the

> use of the said trademark . . . by the defendant . . . is a false description and representation that plaintiff's goods are made by, sponsored by, or otherwise affiliated with defendant or that defendant received authorization from plaintiff to use the trademark.

The allegation is frivolous on its face for there is no reason to believe that consumers will focus at all on a background prop in the Film and pause to consider its source, much less to make the giant leap that the pinball machine was made or sponsored by Paramount. *See Wham-O, Inc. v. Paramount Pictures Corp.*, 286 F. Supp. 2d 1254, 1262 (N.D. Cal. 2003), *appeal dismissed*, 101 Fed. Appx. 248 (9th Cir. 2004) (in rejecting plaintiff's trademark and unfair competition claims arising from the use of plaintiff's SLIP 'N' SLIDE trademark and product in motion picture, explaining that "[c]onsumers and viewers will not mistake plaintiff for a movie production house, and consumers and viewers will not mistake defendants for a purveyor of toys.").

The allegation is further and demonstrably frivolous for the simple reason that the name "Gottlieb" is clearly identifiable only three times in the Film for a total of approximately nine seconds.[8] In trademark cases, like copyright ones, courts are not concerned with "*de minimis* situations." *See Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 717 (Fed. Cir. 1992); *Sandoval*, 147 F.3d at 218.

Finally, there can be no harm from Paramount lawfully obtaining Gottlieb's product and using it as a prop in the Film.. *See, e.g., Sherwood 48 Assocs. v. Sony Corp. of Am.*, 213 F. Supp. 2d 376, 377 (S.D.N.Y. 2002) (dismissing § 43(a) claim arising from defendant's use of plaintiff's Times Square buildings in motion picture set in New York City), *aff'd in part, vacated in part on other grounds*, 76 Fed. Appx. 389 (2d Cir. 2003) (ordering dismissal on remand); *Felix the Cat Prodns. Inc. v. New Line Cinema Corp.*, 54 U.S.P.Q.2d 1856, 1858 (C.D. Cal. 2000) (dismissing trademark infringement, false designation and unfair competition claims); *Rock & Roll Hall of Fame and Museum, Inc. v. Gentile Prods.*, 71 F. Supp. 2d 755, 764 (N.D. Ohio 1999) (no Lanham Act violation where defendant used plaintiff's mark -- "Rock N' Roll Hall of Fame" -- to describe defendant's goods, posters of the Rock N' Roll Hall of Fame building).[9]

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[8] The allegation in paragraph 12 of the Complaint that the trademark is utilized for "approximately 3 minutes within the film" is simply misleading. The period of time that the name is discernable to viewers is approximately nine seconds.

[9] Gottlieb's Third through Sixth Claims for Relief are similarly unavailing. The unfair competition claim fails for the same reasons the Second Claim for Relief fails. The elements of that claim "mirror Lanham Act claims." *Information Superhighway, Inc. v. Talk Am., Inc.*, 395 F. Supp. 2d 44, 56 (S.D.N.Y. 2005). Gottlieb's Fourth Claim for unjust enrichment also fails because there has been no infringement, and therefore Paramount has not been "unjustly enriched." Gottlieb's Fifth Claim under § 349 of the New York General Business Law, a consumer protection statute, is inappropriate here. "'Private transactions not of a recurring nature or without ramifications for the public at large' do not fall within the purview of section 349." *Netzer v. Continuity Graphic Assocs., Inc*, 963 F. Supp. 1308, 1323 (S.D.N.Y. 1997) (quoting *Genesco Entm't v. Koch*, 593 F. Supp. 743, 752 (S.D.N.Y. 1984)). Finally, "injunctive relief" is a remedy, not a stand-alone cause of action. *See Fare Deals Ltd. v. World Choice*

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For the reasons stated above, Gottlieb's trademark count fails to state a claim and should be stricken.

CONCLUSION

For the foregoing reasons, defendant Paramount Pictures Corporation respectfully requests that the Court grant its motion to dismiss plaintiff Gottlieb Development LLC's complaint, and for such other and further relief as may be just and proper.

Dated: New York, New York
July 11, 2008

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Travel.Com, Inc., 180 F. Supp. 2d 678, 682 n.1 (D. Md. 2001) ("a request for injunctive relief does not constitute an independent cause of action; rather, the injunction is merely the remedy sought for the legal wrongs alleged in the . . . substantive counts [of the complaint]."); *see also In re Minpeco USA, Inc.*, 237 B.R. 12, 31 (Bankr. S.D.N.Y. 1997) ("The constructive trust claim in Count VII is not a claim but a remedy and cannot afford an independent basis for holding [defendant] liable.").